

**Remarks**

Applicants respectfully request reconsideration of the above-identified application. Claims 1-31 and 34-38 remain in this application. Claim 23 has been amended. New claims 37-38 have been added. Claims 32-33 have been canceled to avoid excess claims fees. Support for the amendment of claim 23 may be found, for example, at page 3, line 24. Support for new claims 37-38 may be found, for example, at pages 19-20.

I. Rejection of independent claim 1 and dependent claims based on art.

Claims 1-6, 11-14, and 16-22 were rejected under 35 U.S.C. §103(a) as obvious in view of U.S. Patent 3,191,849 to Gutowski combined with U.S. Patent 6,520,332 to Barmore. Applicants respectfully traverse.

As an initial matter, although Barmore may be excluded as a reference available as §102(e) prior art under §103(c) because Barmore was under common ownership (or an assignment obligation to the same person) at the time the present invention was made; nevertheless, there exists an earlier published PCT application corresponding to Barmore, namely, WO 2001/034497 published May 17, 2001. For convenience sake, therefore, this response cites to the Barmore '332 reference as in the Office action rather than citing to the corresponding earlier-published PCT publication.

Applicants respectfully submit that a *prima facie* case of obviousness has not been established because Gutowski *teaches away* from the use of support members that *circumscribe* a chamber portion.

A reference “must be considered in its entirety, i.e., as a *whole*, including portions that would lead away from the claimed invention. (MPEP §2141.02, page 2100-95, Rev. 1, Feb. 2000 (emphasis in original).) “It is improper to combine references where the references teach away from their combination.” MPEP 2145 §X.D.2.

Gutowski teaches that support members 9 (or any of 20, 30, 35, 44, 45, and 59) extend along *only* the two longitudinal sides of the package. (Figures 3-9; column 4, lines 45-

49.) Thus, “the support members are secured *in two side* edges of the container.” (Column 3, lines 30-32; emphasis added.) Gutowski teaches that the transverse ends of the package do *not* incorporate support members: “it is necessary to seal the marginal portions [i.e., transverse ends] *that do not include support members.*” (Col. 5, lines 11-13; emphasis added.) Because Gutowski teaches that the transverse ends do not include support members, Gutowski teaches away from a frame or support members that circumscribe the chamber portion.

It is theorized that reason that Gutowski teaches that the transverse ends of the container do not include support members is so that the container can be supplied with at least one transverse end “open to permit filling and then sealed after insertion of a commodity into a container.” (See column 5, lines 18-24.) The use of a support member at both transverse ends of the Gutowski container would interfere with this insertion of the commodity into the container, because the transverse ends would already be sealed closed to incorporate the support members. Thus, the Gutowski container has its longitudinal sides sealed to incorporate the support members; however, the remaining transverse end portions are open – without support members -- so that the sealing can occur after the commodity is inserted. (Column 5, lines 67-75.)

Regardless of why, however, the fact is that Gutowski teaches that the transverse ends do not incorporate support members. This is further demonstrated by the way that Gutowski teaches for making the container. (Figure 8; column 4, line 39 to col. 5, line 5.) Figure 8 shows that the support members 44 and 45 are sealed along the side of the “tube-like body” while the transverse ends do not include support members. The transverse ends are sealed without support members “in the normal use of the containers in packaging commodities” – that is, “after a commodity is put in the container.” (*Id.*) To place support members at the transverse end portions of the Gutowski container would run directly contrary to the ways that Gutowski taught both for making the container and also for using the container.

Further, Gutowski teaches a watertight chamber portion in the context of vacuum packaging. (Column 5, line 55 to col. 6, line 8.) The chamber portion of the Gutowski is initially provided with “open seam areas.” (Col. 5, lines 63, 70.) The chamber portion of the container is left open so that air can be evacuated from the chamber through the open passageway

– which is sealed closed to form a watertight chamber only after the air is evacuated by the vacuum packaging machinery.

Therefore, Gutowski when considered in its entirety *teaches away* from a frame or support members that circumscribe a watertight chamber portion.

Barmore was cited to show a circumscribing inflated hollow frame. (Office action mailed 9/3/08 at page 2, section 2.) However, as discussed above, Gutowski teaches away from circumscribing the chamber with a support member, much less an inflated support member.

Further, a *prima facie* case of obviousness also requires that the prior art provide a reasonable expectation that the proposed modification will succeed. (MPEP §2142.) The reasonable expectation of success must *not* be based on applicant's disclosure. (*Id.*)

In the present case, the Office action fails to provide any basis (other than the Applicants' disclosure) for a reasonable expectation that it would have been at all possible to make the proposed Gutowski/Barmore combination. Nowhere is there a reasonable expectation of success that one could form the inflatable hollow frame of Barmore around a watertight chamber of Gutowski. Barmore fails to teach a watertight chamber; and Gutowski fails to teach a circumscribing inflatable frame. There is no teaching of how to make the proposed combination of an inflatable frame circumscribing a watertight chamber, nor any reasonable expectation that such a proposed combination would succeed.

The dependent claims 2-6, 11-14, and 16-22 have recitations in addition to those of independent claim 1 from which they depend, and are therefore further patentable over the proposed combination.

U.S. Patent 5,582,853 to Marnocha was cited in combination with Gutowski and Barmore with respect to dependent claims 7 and 10. However, Marnocha fails to supplement the above-noted shortcomings of Gutowski and Barmore with respect to independent claim 1.

U.S. Patent 4,278,198 to Norton was cited in combination with Gutowski and Barmore with respect to dependent claim 8. However, Norton fails to supplement the above-noted shortcomings of Gutowski and Barmore with respect to independent claim 1.

U.S. Patent 3,873,735 to Chalin was cited in combination with Gutowski and Barmore with respect to dependent claim 9. However, Chalin fails to supplement the above-noted shortcomings of Gutowski and Barmore with respect to independent claim 1.

U.S. Patent 5,692,833 to DeLuca was cited in combination with Gutowski and Barmore with respect to dependent claim 15. However, DeLuca fails to supplement the above-noted shortcomings of Gutowski and Barmore with respect to independent claim 1.

## II. Rejection of independent claim 23 and dependent claims based on art.

As previously presented, independent claim 23 and dependent claims 25-36 were rejected under 35 U.S.C. §103(a) as obvious in view of Gutowski combined with Barmore and Marnocha. Applicants respectfully traverse as conceivably applied to the amended claims.

Amended independent claim 23 is directed to a process of packaging, and requires “sealing the lid web to the base web . . . to form a watertight chamber portion enclosing the product” and “sealing the lid web to the base web . . . to form a hollow frame circumscribing the chamber portion and adapted to support the chamber portion when inflated.”

Thus, independent claim 23 recites “a hollow frame circumscribing the chamber portion” as does independent claim 1. Accordingly, the discussion set forth above in Section I regarding why Gutowski *teaches away* from circumscribing the chamber with a support member (e.g., the inflated hollow frame disclosed in Barmore) applies with equal force with respect to independent claim 23. Marnocha fails to teach or suggest anything regarding a circumscribing hollow frame.

Further, Marnocha fails to supplement the teachings of the proposed Gutowski/Barmore combination to provide a reasonable expectation of success that one could form the inflatable hollow frame of Barmore around the product chamber of Gutowski. As set forth in the Section I discussion, there is no teaching of how to make the proposed combination of an inflatable frame circumscribing a watertight chamber, nor any reasonable

expectation that such a proposed combination would succeed. Marnocha fails to supplement this lack of expectation of success.

Marnocha is directed to the known process of thermoform vacuum packaging. Nothing in Marnocha teaches or suggests that it would have been obvious to form a hollow inflatable frame to circumscribe a watertight chamber portion.

Further, with respect to dependent claim 36, the Office action states that it would have been obvious to “simultaneously” seal the lid web to the base web to form both the chamber portion and the circumscribing hollow frame portion. Applicants respectfully traverse. The Office action states that “simultaneous sealing was the conventional method.” However, none of the applied references teaches any simultaneous sealing to form both a watertight chamber portion and a circumscribing hollow frame. Accordingly, Applicants respectfully submit that such sealing simultaneity is not conventional with respect to forming watertight chamber portions with circumscribing hollow frames. To be sure, forming simultaneously would be “faster” as stated in the Office action; however, there is nothing in the prior art to show a reasonable expectation that one could perform such sealing simultaneously in making the recited structure of a watertight chamber portion circumscribed by a hollow frame.

U.S. Patent 5137154 to Cohen was cited in combination with Gutowski, Barmore, and Marnocha with respect to dependent claim 24. Cohen fails to supplement the above-noted shortcomings of Gutowski, Barmore, and Marnocha with respect to independent claim 23 as discussed above.

### III. Conclusion

In view of the amendments to the claims and these remarks, it is respectfully submitted that the present application is in condition for allowance. A notice to that effect is earnestly and respectfully requested.

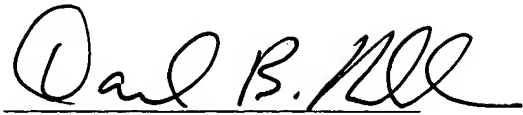
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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Daniel B. Ruble", written over a horizontal line.

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